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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,977	09/05/2003	Thomas Koehler	WAS 0600 PUS / Wa 10217-S	4036
22045	7590	05/31/2005	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			MOORE, MARGARET G	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/655,977	Applicant(s) KOEHLER ET AL.	
	Examiner Margaret G. Moore	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 to 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 to 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Weidner et al.

Weidner et al. teach a method for preparing polyorganosiloxane resins. This comprises reacting in a first stage compounds (I) and (II) in the presence of water and an acid, while alcohol formed is at least partly distilled. See column 1, line 40, through column 2, line 15. This meets the claimed first stage. Patentees then react the reaction mass with a base and a water insoluble solvent to obtain a homogeneous reaction mass, and removes water and alcohol by distillation. See column 2, lines 16 to 22. This meets the claimed second stage. Patentees then neutralize the reaction mass by adding an acid and distilling water and alcohol. They also remove any precipitated salt. This meets the claimed third stage and part of the fourth stage. The water insoluble solvent is subsequently removed, meeting the claimed fifth stage.

For a teaching meeting the remaining portion of the fourth stage (treating the reaction mixture obtain in the third stage with an organopolysiloxane) the Examiner draws applicants' attention to two teachings. First note column 7, lines 42 and 43, which teaches that the resin prepared is at least partly, but most preferably completely, soluble in liquid organopolysiloxane. Since this requires adding the resin prepared by Weidner et al. to an organopolysiloxane, this meets the "treating with at least one organopolysiloxane" requirement in the claimed fourth stage. Further evidence of anticipation can be found on the top of column 11, in which a reaction mass from stage 3, after precipitated salt has been removed, is admixed with a polydimethylsiloxane. Note that organic solvents are then removed, meeting the fifth stage.

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In this manner the instant claims are fully met by the teachings in Weidner et al. The polydimethylsiloxane meets claims 3 to 7. The specific requirements in claims 8 and 10 are found on column 6, line 40 and on. Column 5, lines 28 to 31, teaches claims 9 and 11.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weidner et al.

Weidner et al. fail to specifically teach the addition of these ingredients. One having ordinary skill in the art, however, would have found the addition of such conventional ingredients to the siloxane resin in Weidner et al. to have been obvious. For instance, Weidner et al. test storage stability of the resin/siloxane treatment mixture. Inhibitors are known additives that increase storage stability and thus the skilled artisan would have been motivated by the desire to improve storage stability to add an inhibitor. On the other hand, the resins therein are useful as antifoams, toners, paints and coating compositions. The addition of an inhibitor to improve the stability in the ultimate compositions would have been obvious to the skilled artisan. On the other hand, adding additional solvent or a rheology modifier in an effort to adjust viscosity and improve the ability of the resin to be coated or ease of application would have been obvious to the skilled artisan.

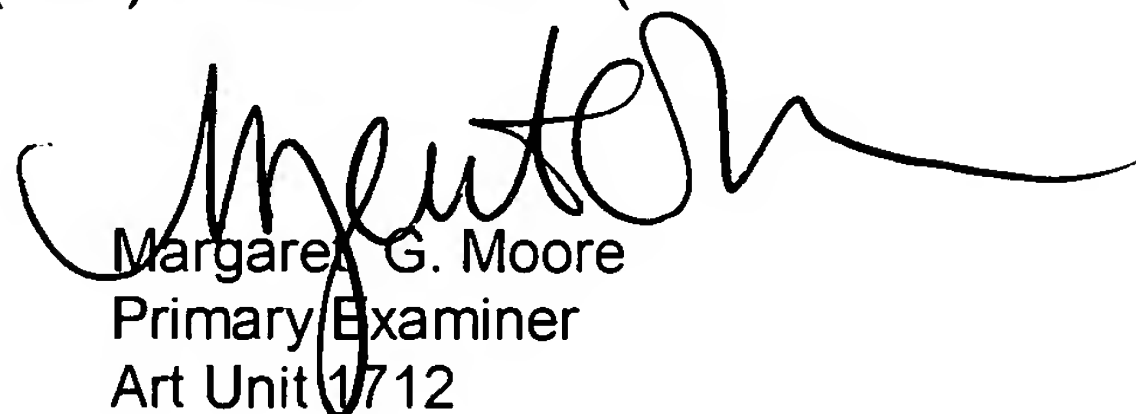
5. Kaepper et al. is cited as being of general interest. This teaches a method of making polyorganosiloxane resins but it is not as specific or as close to the instant claims as the teachings in Weidner et al.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
5/26/05